Remarks

Claims 1-19 are pending in this application. Claims 20 and 21 have been added by amendment herein.

In the Office Action, the Examiner rejected claims 1-6, 8, 10-15, 17 and 19 under 35 U.S.C. § 102(e) and claims 7, 9, 16 and 18 under 35 U.S.C. § 103(a). The Examiner also rejected claims 1-9 and 19 under 35 U.S.C. § 101. Applicants respectfully traverse these rejections. For the reasons set forth below, Applicants believe the claims are in condition for allowance and notice to that effect is earnestly solicited.

Claim Amendments

Claims 1 and 10 have been amended to recite indicia coding the components on the pictorial representation "to indicate which components may be used to build other components;" "which components may be used to manage the system and its components;" and "which components may be used to support other components of the system." This claim is supported in the specification for example at page 22, lines 3-5.

Claim 19 has been amended to recite indicia coding the components on the pictorial representation "to indicate which components of the system may be used to build other components of the system." The amendment is supported in the specification at page 22, lines 3-24. Parts (c) and (d) of the claim have been deleted. Claim 19 has also been amended to replace "logic" with --means--.

New claims 20 and 21 have been added. Claim 20 recites a method for identifying various components of a system that includes the step of "presenting information relating to building the components of the system by indicia coding the components on the pictorial

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representation to indicate which components of the system may be used to build other components of the system."

Claim 21 recites a computer program that includes a code segment that presents information relating to the components of the system by indicia coding the components on the pictorial representation to indicate at least one of the following:

which components of the system may be used to build other components of the system;

which components may be used to manage the system and its components; and

which components may be used to support other components of the system.

Claims 20 and 21 are supported in the specification for example in the specification for example at page 22, lines 3-24.

Applicants submit that no new matter has been added.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claim 1-6, 8, 10-15, 17, and 19 under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 5,819,092 to Ferguson et al.

Ferguson et al. teaches a visual editing system for creating commercial online computer services. In Figure 3a, Ferguson provides a flow diagram of steps to illustrate how an online designer is used to create an online service.

In the Office Action, the Examiner referred to Figures 7, 8, 15, and 16 to support the rejection of claim 1. FIG. 7 illustrates the set of Utility Subtools in the Online Designer development tool. FIG. 8 illustrates a block diagram example of an online service. FIG. 15 illustrates a screen display of a hypermedia document. FIG. 16 illustrates a screen display of a hypermedia document used to order a product.

In response to Applicant's argument that Ferguson does not show indicia coding of

components on a pictorial representation to convey information relating to building, managing,

and supporting components of the existing system as recited in the claims, the Examiner stated:

The icons/displays of Ferguson et al ('092), see figure 7 and 8 which refer to the screens of figures 15 and 16 are seen to be indicia coding/pictorial representation of the components of the system claimed. The management of the components is performed through the manipulations of the document's appearance of figure 3a.

The Examiner also repeated his prior rejection of claim 1:

Ferguson et al ('092) discloses:
(a)   displaying a pictorial representation of an existing system including a plurality of components, see figures 3a, 7-13, also column 19, line 42 - Column 20, line 18;
(b)   presenting information related to building the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (315,320,330);
(c)   conveying information relating to managing the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (317);
(d)   presenting information relating to supporting the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (340, 362).

Applicants respectfully transverse this rejection.

Ferguson does not teach or suggest in Figs 3a, 7, 8 or elsewhere the use of indicia coding

to indicate "which components may be used to build other components;" "which components

may be used to manage the system and its components;" and "which components may be used to

support other components of the system," as recited in the claims. Fig. 3 of Ferguson textually

describes steps in an online designer flow diagram but does not use indicia coding to indicate

which components may be used for building, managing, and supporting components. For

example, steps 315, 320, and 330 of Figure 3a do not use indicia coding "to indicate which

components may be used to build other components" as required by claim 1 as amended.

Similarly, Fig. 7 shows Utility Subtools but does not teach or suggest using indicia coding to

indicate which components may be used for building, managing, and supporting components. Fig. 8 merely illustrates a block diagram example of an online service but again does not teach or suggest using indicia coding to indicate which components may be used for building, managing, and/or supporting components, as recited in the claims.

The recited indicia coding for indicating which components may be used for building, managing, and supporting components is not non-functional descriptive material and should be taken to account in consideration of the claims. See In re Dembiczak, 175 F.3d 994, 1000 (Fed. Cir 1999); MPEP §2106 VI. Applicant also notes the Federal Cicuit has recently emphasized the duty to make factcual findings in compliance with the Administrative Procedure Act and to "explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 61 USPQ2d 1430 (CA FC 2002).

Accordingly, it is believed that the claims fully comply with § 102(e), and withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 7, 9, 16, and 18 under 35 U.S.C. 103(a) as unpatenable over United States Patent No. 5,819,092 to Ferguson et al in view of United States Patent No. 6,323,952 to Blower, Jr. et al. Applicants respectfully traverse these rejections.

Claims 1 and 9 depend from claim 1 and Claims 16 and 18 depend from claim 10. These claims are allowable at least because they depend from an allowable independent claim. Accordingly, it is believed that the claims fully comply with § 103(a), and withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 U.S.C. § 101

The Examiner rejected claims 1-9 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Rejection of Claims 1-9 under 35 U.S.C. §101

Regarding claims 1-9, the Examiner stated that "Though the claim recites a method of displaying, presenting, conveying and presenting again, there is no technological apparatus which is manipulated to perform the steps and not in the technological arts, it is therefore non-statutory." Applicants respectfully traverse this rejection.

The Federal Circuit has squarely held that subject matter may be patentable without a physical act or physical transformation. State Street Bank & Trust v. Signature Financial Group Inc., 149 F.3d 1368, 1375 (Fed. Cir. 1998). In State Street Bank, the Federal Circuit declared that "it is no ground for holding a claim is directed to nonstatutory subject matter to say it includes or is directed to an algorithm" Id. at 1375 quoting In re Iwahashi, 888 F.2d 1370, 1374 (Fed. Cir. 1989). The court explained that "Unpatentable mathematical algorithms are identifiable by showing they are merely abstract ideas constituting disembodied concepts or truths that are not 'useful.' From a practical standpoint, this means that to be patentable an algorithm must be applied in a 'useful' way." State Street Bank, 149 F.3d at 1373.

Section 2106 of the MPEP provides further guidelines for determining whether a process claim recites statutory subject matter. A claimed process including a mathematical or other abstract idea is statutory if the claimed process is "limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible, and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible, and useful." MPEP 2106(IV)(B)(2)(b)(ii) (Eighth Edition) (citations omitted). Examples of a

"concrete, tangible, and useful" result include a smooth waveform, see In Re Alappat, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994), data indicating the condition of a patient's heart, see Arrhythmia Research Technology Inc, v. Corazonix Corp., 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992), and a final share price, see State Street Bank, 149 F.3d 1368.

Applicants submit that claim 1 produces a concrete, tangible, and useful result. For example, the claimed method displays a pictorial representation of an existing system including a plurality of components, presents information relating to building and supporting the components by indicia coding the components and conveys information relating to managing the components. The claimed steps are not a "disembodied concept[] or truth[]," State Street Bank, 149 F.3d at 1373, but rather provide a useful summary information relating to building, managing, and supporting the components of a system, such as which components may be used for building, managing, or supporting other components.

In addition, Applicants submit that claim 1 for example recites the physical acts of "displaying a pictorial representation of an existing system" and "presenting information relating to building the components of the system by indicia coding the components on the pictorial representation." For example, in one embodiment, displaying the pictorial representation and presenting information relating to building the components by indicia coding may involve a display device coupled to a computer system. See Application, p. 39.

Rejection of Claim 19 under 35 U.S.C. §101

Regarding claim 19, the Examiner stated that "Though the claim recites a system, only logic appears in the body of the claim, there is no technological "means" to perform the logic and not in the technological arts, it is therefore non-statutory." Applicants respectfully traverse this rejection. Claim 19 has been amended to replace "logic" with --means--.

Accordingly, it is believed that the claims fully comply with § 101. Withdrawal of this rejection is respectfully requested.

Interview Summary

On February 10, 2003, a telephone interview was conducted including Examiner Thomas A. Dixon, Katherine M. DeVries Smith of Merchant & Gould, and Applicant's undersigned representative, Jeffrey P. Cook. Applicants' claim 1 and the Ferguson reference were discussed, but no agreement was reached. Applicants agreed to submit in writing their arguments about the claim elements that are missing in Ferguson and Blower.

Summary

In summary, each of claims 1-21 are in condition for allowance and a notice of allowance is respectfully requested.

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PATENT TRADEMARK OFFICE

Date: February 10, 2003

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<u>**VERSION WITH MARKINGS TO SHOW CHANGES MADE**</u>

<u>**In The Title**</u>

[SYSTEM, METHOD, AND ARTICLE OF MANUFACTURE FOR] BUILDING, MANAGING, AND SUPPORTING VARIOUS COMPONENTS OF A SYSTEM

<u>**In the Claims**</u>

1.   A method for identifying various components of a system for building, management, and support purposes comprising the steps of:

(a) displaying a pictorial representation of <u>a system</u> [an existing system] including a plurality of components <u>for building other components, managing the system and its components, and supporting other components of the system</u>;

(b) presenting information relating to building the components of <u>the system</u> [the existing system] by indicia coding the components on the pictorial representation <u>to indicate which components may be used to build other components</u>;

(c) presenting information relating to managing the components of <u>the system</u> [the existing system] by indicia coding the components on the pictorial representation <u>to indicate which components may be used to manage the system and its components</u>; and

(d) presenting information relating to supporting the components of <u>the system</u> [the existing system] by indicia coding the components on the pictorial representation <u>to indicate which components may be used to support other components of the system</u>.

10.   A computer program embodied on a computer readable medium for identifying

various components of a system for building, management, and support purposes comprising:

(a) a code segment that displays a pictorial representation of <u>a system</u> [an existing system]

including a plurality of components <u>for building other components, managing the system and its</u>

<u>components, and supporting</u> other components of the system; <u>and</u>

(b) a code segment that presents information relating to building the components of <u>the system</u>

[the existing system] by indicia coding the components on the pictorial representation <u>to indicate</u>

<u>which components of the system may be used to build other components of the system.</u> [;]

(c) a code segment that conveys information relating to managing the components of <u>the system</u>

[the existing system] by indicia coding the components on the pictorial representation <u>to indicate</u>

<u>which components may be used to manage the system and its components</u>; and

(d) a code segment that presents information relating to supporting the components <u>the system</u>

[the existing system] by indicia coding the components on the pictorial representation <u>to indicate</u>

<u>which components may be used to support other components of the system</u>.

19. A system for identifying various components of a system for building, management, and support purposes comprising:

(a) [logic] <u>means</u> for displaying a pictorial representation of <u>a system</u> [an existing system] including a plurality of components, <u>at least some of the components being usable to build other components of the system</u>;

(b) [logic] <u>means</u> for presenting information relating to building the components of the existing system by indicia coding the components on the pictorial representation <u>to indicate which components of the system may be used to build other components of the system.</u> [;]

[(c) logic for conveying information relating to managing the components of the existing system by indicia coding the components on the pictorial representation; and]

[(d) logic for presenting information relating to supporting the components of the existing system by indicia coding the components on the pictorial representation.]